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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/786,077	02/28/2001	Sandro Campestrini	CM 1903/MH	8480

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EXAMINER	
DELCOTTO, GREGORY R	
ART UNIT	**PAPER NUMBER**
1751	

DATE MAILED: 03/25/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/786,077	CAMPESTRINI ET AL.	
	Examiner	Art Unit	
	Gregory R. Del Cotto	1751	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *Amend. filed 1/6/04*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1 and 4-15* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1 and 4-15* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. Claims 1 and 4-15 are pending. Applicant's arguments and amendments presented 1/6/04 have been entered.

Objections/Rejections Withdrawn

2. The following objections/rejections as set forth in the Office action mailed 10/1/03 have been withdrawn:

The rejection of claims 1 and 4-15 under 35 USC 112, second paragraph, has been withdrawn.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical

Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1 and 4-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kaiserman et al (US 5,338,474) for the reasons of record set forth in Paper #4.

Additionally, Kaiserman et al teach that the system would be useful in normally basic aqueous solutions, in relatively neutral solutions and even in acidic solutions. See column 3, lines 45-55. '621 teaches that the compositions have a pH of from about 3 to about 13. See page 3, lines 1-10.

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to formulate a bleaching composition having the specific pH containing a specific diacyl peroxide which provides stain removal and improved fabric color safety as recited by the instant claims, with a reasonable expectation of success and similar results with respect to other disclosed components, because the broad teachings of Kaiserman et al or '621 suggest such a bleaching composition having the specific pH containing a specific diacyl peroxide which provides stain removal and improved fabric color safety as recited by the instant claims.

Claims 1 and 4-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 98/03621 for the reasons of record set forth in Paper #4.

Additionally, with respect to claim 13, the Examiner asserts that the broad teachings of '621 would suggest a surfactant system in which one is hydrophobic with an HLB of less than 9 and one is hydrophilic with an HLB greater than 10.

Response to Arguments

With respect to Kaiserman, Applicant once again states that this disclosure is limited to a composition and does not teach a method of removing stains from fabric and improving color safety. In response, note that, the Examiner maintains that the bleaching compositions as taught and suggested by Kaiserman et al would have the same stain removal and fabric color safety properties as recited by the instant claims because Kaiserman et al teach methods of bleaching fabrics using compositions containing the same components in the same proportions as recited by the instant claims. In fact, various examples disclosed by Kaiserman et al are drawn to cleaning fabrics as recited by the instant claims. Note that, the reason or motivation to modify the reference may often suggest what the inventor has done, but for a different purpose or to solve a different problem. It is not necessary that the prior art suggest the combination to achieve the same advantage or result discovered by Applicant. In re Linter, 458 F.2d 1013, 173 USPQ 560 (CCPA 1972).

Additionally, Applicant states that the breadth in scope of Kaiserman with respect to the DAP's results in little or no suggestion to the ordinary practitioner that a limited number of DAP compositions within that scope might be employed for the very specific end use of removing fabric stains while improving color fabric safety as taught by Applicants. Additionally, Applicant argues that there is no suggestion in Kaiserman to select aliphatic-aromatic peroxides from the enormous number of diacyl peroxides covered by the general formula. Note that, in response, the Examiner asserts that the disclosure of Kaiserman et al is not overly broad and that Kaiserman et al suggests the specific acyl peroxide as recited by the instant claims. Kaiserman et al teaches that R

and R1 may be selected from alkyl having 1 to 20 carbon atoms, aryl, and alkaryl which is a fairly small group of choices for the substituents, and all that one of ordinary skill in the art would need to do to formulate the claimed composition is choose one of R and R1 to be an alkyl group and one to be a phenyl group which is clearly suggested by the teachings of Kaiserman et al. While Applicant argues that Kaiseman et al prefers benzoyl peroxide as the bleaching agent and that benzoyl peroxide is the only diacyl peroxide exemplified, the Examiner maintains that the teaching of a reference is not limited to the preferred embodiments and Kaiserman et al suggest a method using the specific alkyl-aryl diacyl peroxide as recited by the instant claims. Note that, Applicant has provided no data or evidence showing the unexpected and superior properties of the claimed invention in comparison to those compositions falling outside the scope of the claimed invention.

With respect to '621 (Ofosu-Asante) Applicant once again states that the claimed invention discloses a method of using an aliphatic-aromatic diacyl peroxide to deliver improved fabric color safety while Ofosu is silent on a method of providing the benefit of fabric color safety and teaches the application of microwaves to achieve better cleaning. The Examiner maintains that the bleaching compositions as taught and suggested by '621 would have the same stain removal and fabric color safety properties as recited by the instant claims because '621 teaches methods of removing stains from fabrics using compositions containing the same components in the same proportions as recited by the instant claims. Note that, the reason or motivation to modify the reference may often suggest what the inventor has done, but for a different purpose or to solve a

different problem. It is not necessary that the prior art suggest the combination to achieve the same advantage or result discovered by Applicant. In re Linter, 458 F.2d 1013, 173 USPQ 560 (CCPA 1972).

Additionally, with respect to Ofoso-Asante, Applicant states that benzyl succinyl peroxide, as disclosed by Ofosu-Asante and falling within the scope of the instant claims, is disclosed in the context of dishwashing and not fabric care. In response, not that, the Examiner maintains that '621 specifically mentions that benzyl succinyl peroxide, a diacyl peroxide falling within the scope of the instant claims, can be used in a method for treating fabrics. See claims 1 and 6 of '621. Clearly, '621 suggests diacyl peroxides as recited by the instant claims in a method of cleaning fabrics.

With respect to the Declaration filed under 37 CFR 1.132, the Examiner maintains that this Declaration is not sufficient to overcome the rejections of record. Note that, the Declaration provides no factual evidence or data showing that the compositions of the instant claims provide unexpected and superior results in comparison to those compositions falling outside the scope of the claimed invention. For instance, a stated previously, in paragraph 5 of the Declaration, Applicant has stated that good color fabric safety demonstrated by compositions falling within the scope of the claimed invention are very different from the results which would have been obtained with compositions falling outside the scope of the claimed invention. There is no factual data or evidence provided to support this contention and this statement is pure speculation since Applicant states "would have been obtained" which indicates that these tests were not even run. Furthermore, while the declaration does

provide opinion evidence, an affidavit or declaration which states only conclusions may have some probative value, such an affidavit or declaration may have little weight when considered in light of all the evidence of record in the application. *In re Brandstadter*, 484 F.2d 1395, 179 USPQ 286 (CCPA 1973). See MPEP 716.01(d).

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory R. Del Cotto whose telephone number is (571) 272-1312. The examiner can normally be reached on Mon. thru Fri. from 8:30 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yogendra Gupta can be reached on (571) 272-1316. The fax phone

number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Gregory R. Del Cotto
Primary Examiner
Art Unit 1751

GRD
March 20, 2004